

REMARKS/ARGUMENTS

This amendment is submitted in response to the Office Action dated May 31, 2006. Reconsideration and allowance is requested.

Claims 23, 25, 26, 28, 32, 34, 46, 49, and 50 remain in this application.

Claim Rejection under 35 USC 102

In the Office Action, claims 23, 25, 26, 28, and 46 were rejected under 35 USC 102(b), as being anticipated by Kent (US 3,711,360). "Under 35 USC § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference..." *Akzo v N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) cert. denied, 482 U.S. 909 (1987).

The Examiner asserted that regarding claim 23,

Kent discloses a shaped polymer substrate comprised of a metallized polymer substrate (1), wherein the shaped polymer substrate is substantially conductive; and a conductive material (6) on at least one surface of the shaped polymer substrate; wherein the shaped polymer substrate comprises polyvinyl chloride, polycarbonate, polybutylene terephthalate, or polyethylene terephthalate glycol (col. 2, lines 10-15).

The Applicant respectfully traverses. Kent does not teach "a shaped polymer substrate comprised of a metallized polymer substrate, wherein the shaped polymer substrate is substantially conductive," as claimed. Kent's shaped polymer substrate is not substantially conductive as claimed because the conductive material (6) is only a strip that surrounds the substrate and does not cover the substrate surface as is clearly depicted in figure 2 which shows that the conductive material 6 is a strip that wraps around the outer edges of the substrate.

Moreover, in column 2 lines 20-22 Kent describes the conductive material as:

Bonded around the front of each bead portion is a metallized foil 6 conveniently comprising a strip of transparent plastics material...

Additionally, Kent's conductive metallized foil 6, which is used for ornamental purposes, cannot serve as an EMI/RFI shielding device because the entire substrate is not

substantially conductive. Since Kent's strip 6 only surrounds the outer edges of the substrate, any EMI and RFI reaching Kent's substrate will penetrate into the non-metallic portions of substrate and cause interference within the substrate. Kent's strip would probably only shield the outer edge of the substrate from EMI and RFI but not the portion of the substrate that is not coated with a conductive material.

Since Kent's strip only surrounds the outer edges of the substrate, the Applicant does not believe that Kent teaches each and every element of the claimed invention. Therefore the Applicant believes that at least this element is not anticipated by Kent under *Akzo* and respectfully requests that the Examiner reconsider his rejection.

In rejecting claim 26 the Examiner pointed to figure 1 and suggested that figure 1 teaches "wherein the conductive material comprises a substantially uniform thickness over at least one surface of the shaped polymer substrate." The Applicant respectfully traverses. First, Kent's figure 1 lacks sufficient resolution to determine if the conductive material has a substantially uniform thickness over at least one surface of the shaped polymer substrate. Second, Kent's figure 1 only shows the conductive material 6 deposited over the beads 3 and not over at least one surface of the shaped polymer substrate, as claimed. Therefore, the Applicant believes that each and every element claim 26 is not disclosed in Kent, and therefore under *Akzo*, Kent does not anticipate claim 26.

In rejecting claim 28, the Examiner again asserted that Kent discloses a shaped polymer substrate comprised of a metallized polymer substrate (1), wherein the shaped polymer substrate is substantially conductive; and a conductive material (6) on at least one surface of the shaped polymer substrate. The Applicant respectfully traverses this rejection for the same reasons mentioned above regarding then rejection of claim 23 including that Kent's shaped polymer substrate is not substantially conductive.

Therefore the Applicant believes that claims 23, 25, 26, 28, and 46 are not anticipated by Kent under *Akzo* and respectfully requests that the Examiner reconsider his rejection.

Claim Rejection under 35 USC 103

In the Office Action, the Examiner rejected claims 32, 34, 49 and 50 under 35 USC 103(a), as being unpatentable over Kent. The Applicant respectfully traverses.

In order to establish *prima facie* obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all of the claimed limitations. The teachings or suggestions to make the claimed invention and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure. See *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2143. The Applicant respectfully submits that the Examiner has not satisfied all three criteria outlined in MPEP 2143.

In rejecting claims 49 and 50 the Examiner acknowledged that Kent does not disclose the conductive material made of copper or nickel. However the Examiner rejected the claims by arguing that,

it would have been obvious to one having ordinary skill in the art at the time the invention was made to use copper, or nickel for the conductive material of Kent for intended purposes, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

From reading Kent it appears that the only reason why Kent uses aluminum is because of the aesthetic properties of aluminum. It does not appear that Kent, or for that matter one skilled in the art, would have chosen to use copper or nickel instead of aluminum unless these materials would have provided the same decorative properties. Since copper looks different than aluminum, a person skilled in the art would not have been motivated to use copper instead of aluminum because the resulting decorative features would look completely different. Although nickel looks closer to aluminum than copper, nickel still looks different enough that if it were used as a substitute for aluminum then the nickel coating could alter the look and feel of

Kent's decorative feature especially after it were aged and exposed to the environment. Moreover, one skilled in the art of making EMI and RFI shields would not have been motivated to modify Kent's decorative coating to make the claimed invention because the skilled artisan would have to first know or realize that this decorative coating might function as a shield for EMI or RFI. Without the benefit of the Applicant's teaching it is unlikely that one skilled in the art would have made the substitution. Therefore the Applicant believes that claims 49 and 50 are not obvious.

In rejecting claims 32 and 34 the Examiner acknowledged that Kent does not disclose the wall shape made of a recycled material and the conductive coating having 1 - 50 microns in thickness. However the Examiner rejected the claims by arguing that,

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Kent by employing the specific thickness of 1-50 microns of the conductive coating of Kent for intended use, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

The Applicant respectfully traverses.

According to *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and MPEP 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose then there is no suggestion or motivation to make the proposed modification. If the metallized foil 6 in Kent were modified as suggested by the Examiner to have a thickness of thickness of 1-50 microns then Kent's modified metallized foil 6 would be unsatisfactory for its intended purpose because Kent's intended purpose is to use the metallized foil for decorative purposes and a foil that is 1-50 microns thick may look hazy or may look tarnished and therefore would not serve well for decorative purposes. The differences between bulk aluminum and thin films of aluminum are even more pronounced for thinner films having thickness closer to the lower range of the claimed 1-50 microns. The Applicant believes that it is not obvious to substitute the bulk aluminum taught by Kent with a film of aluminum having a thickness ranging between 1-50 microns because an aluminum film of this thickness

Appl. No. 10/659,838
Amdt. dated August 30, 2006
Reply to Office Action of May 31, 2006

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would probably not have the same decorative features as intended by Kent. Therefore, under *In re Gordon*, and MPEP 2143.01 there is no suggestion or motivation to make the proposed modification.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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